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09/553,695	04/21/2000	MARVIN T LING	GTX-001	6472

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EXAMINER
KANOF, PEDRO R

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/553,695	Applicant(s) LING	
	Examiner KANOF	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ___*three*___ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 21, 2000* _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-27* _____ is/are pending in the application.

    4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-27* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

    a) ☐ All b) ☐ Some* c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *2*

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. (U.S.

Patent No. 5,815,657)(hereafter <u>Williams</u>).

Claim 27:   Williams disclose a server operated by a vendor that provides products for

sale or rental through a network, the server comprising:

a network interface through which the server communicates with a user over the network

(Col. 12, lines 41-46);

a database (Col. 14, lines 24-28);

a memory (Col. 13, line 67-col. 14, lines 6);

a processor that executes software stored in the memory (Col. 15, line 61-col. 16, line 4,

and col. 16, lines 22-38), the software including one or more programmed routines, the

programmed routines comprising:

a registration routine that opens a user account in the database for the user (Col. 2, lines 9-16 and col. 1, lines 31-42);

an electronic token sale routine that issues one or more electronic tokens from the vendor to the user, and adds the one or more electronic tokens to the user account (Col. 1, lines 16-26 and col. 17, lines 49-57);

a display routine that displays the prices of the products in units of electronic tokens (Col. 31, lines 2-20);

a selection routine that permits the user to select a subset of the products for purchase, a total price of the subset of the products being computed in units of electronic tokens (Col. 31, lines 24-40); and

a purchase routine that determines if the user account contains electronic tokens having a value equal to or greater than the total price, and if so, subtracts the total price from the user account (Col. 1, lines 27-37 and col. 21, line 24-col. 22, line 25).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et

al. (U.S. Patent No. 5,815,657)(hereafter Williams), and further in view of Fujimoto (U.S. Patent

No. 6,018,720).

        Claim 1:   Williams discloses a method of conducting electronic commerce, the method

comprising:

        opening a user account with a vendor for a user (debts cards uses accounts with a vendor

of a service, Col. 2, lines 9-14 and Col. 1, lines 31-42);

        issuing one or more electronic tokens from the vendor to the user, and adding the one or

more electronic tokens issued by the vendor to the user account (Col. 14, line 42-Col. 15, line 4);

        permitting the user to select a subset of the products and services for purchase (Col. 15,

line 61-col. 16, line 3 and col. 18, lines 2-8);

        computing a total price for the selected subset of the products and services in units of

electronic tokens (Col. 13, lines 41-45).

        However, Williams does not explicitly disclose providing products-and services that may

be purchased through the vendor, wherein prices for the products and services are listed in units

of electronic tokens. Fujimoto discloses providing products-and services that may be purchased

through the vendor, wherein prices for the products and services are listed in units of electronic

tokens (Col. 15, lines 60-65). Therefore, it would have been obvious to one having ordinary skill

in the art at the time the invention was made to providing products and services that may be

purchased through the vendor, wherein prices for the products and services are listed in units of

electronic tokens, defining a unit able to pay also calls for few cents, such as in the telephonic

industry. One would have been motivated to including this step in order to increase the flexibility

of the system.

Williams also discloses the step wherein if the user account contains electronic tokens

having a value equal to or greater than the total price, permitting the user to purchase the selected

subset of the products and services, and subtracting the total price from the user account (Col. 11,

lines 53-63, col. 13, lines 45-53, col. 15, lines 30-52, and col. 16, lines 9-17). Fujimoto also

discloses such as a step (Col. 3, lines 18-36). Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to include such a step. One

would have been motivated to including this step in order to increase the flexibility of the system.

Claim 2:   Williams and Fujimoto disclose the method of claim 1. Williams also

discloses issuing one or more electronic tokens from the vendor to the user comprises permitting

the user to purchase the one or more electronic tokens from the vendor (Col. 17, lines 49-57).

Claim 3:   Williams and Fujimoto disclose the method of claim 2. Williams also

discloses permitting the user to purchase the one or more electronic tokens from the vendor

comprises permitting the user to conduct an on-line transaction using a credit card to purchase the

one or more electronic tokens (Col. 2, lines 9-17, col. 18, lines 27-30 and claim 21, lines 26-28).

Claim 4:   Williams and Fujimoto disclose the method of claim 2.   Williams also discloses permitting the user to purchase the one or more electronic tokens from the vendor comprises permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens (Col.2, lines 18-20).

Claim 5:   Williams and Fujimoto disclose the method of claim 4.   Williams also discloses permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use a purchase order to purchase the one or more electronic tokens (Col. 2, lines 20-36).

Claim 6:   Williams and Fujimoto disclose the method of claim 4. However, the references does not explicitly disclose permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to request to be billed for the one or more electronic tokens. Official notice is taken that the step of permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to request to be billed for the one or more electronic tokens is old and well known within the art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 7:   Williams and Fujimoto disclose the method of claim 4.   Williams also discloses permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use phone, fax, mail, or e-mail to purchase the one or more electronic tokens (Col. 1, lines 17-24).

Claim 8:   Williams and Fujimoto disclose the method of claim 4.   Williams also discloses permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to purchase electronic tokens without using a credit card (Col. 21, lines 23-28).

Claim 9:   Williams and Fujimoto disclose the method of claim 1. wherein issuing the one or more electronic tokens comprises setting a price for the one or more electronic tokens, the price determined by the vendor (Col. 15, lines 60-65).   Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to issuing the one or more electronic tokens comprises setting a price for the one or more electronic tokens, the price determined by the vendor. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 10:   Williams and Fujimoto disclose the method of claim 1. Williams also

discloses wherein opening a user account with a vendor comprises registering the user with the

vendor (Col. 2, lines 9-14).

Claim 11:   Williams and Fujimoto disclose the method of claim 10. Williams also

discloses wherein registering the user with the vendor comprises recording personal information

about the user in a database maintained by the vendor (Col. 10, line 65-col. 11, line 4, col. 18,

lines 33-37). Also Fujimoto discloses such as a step (Col. 1, lines 23-45).

Claim 12:   Williams and Fujimoto disclose the method of claim 11. Williams also

discloses wherein registering the user with the vendor comprises acquiring personal information

about the user through off-line communications (Col. 11, lines 31-38)

Claim 13:   Williams and Fujimoto disclose the method of claim 10. However, the

references does not explicitly disclose wherein opening a user account with the vendor further

comprises issuing a predetermined minimum number of electronic tokens to the user. Official

notice is taken that the step of opening a user account with the vendor further comprises issuing a

predetermined minimum number of electronic tokens to the user is old and well known within the

art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 14: Williams and Fujimoto disclose the method of claim 1. However, the references does not explicitly disclose comprising issuing additional electronic tokens to the user. Official notice is taken that the step issuing additional electronic tokens to the user is old and well known within the art. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 15: Williams and Fujimoto disclose the method of claim 14. Fujimoto also discloses wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens if the user account does not contain enough electronic tokens to cover the total price of the selected subset of products and services (Col. 3, lines 18-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to including this step. One would have been motivated to including this step in order to increase the flexibility of the system.

Claim 16: Williams and Fujimoto disclose the method of claim 14. Williams also discloses wherein issuing additional electronic tokens to the user comprises permitting the user to

purchase additional electronic tokens through an on-line transaction using a credit card, without

disrupting a process of selecting products and services (Col. 17, lines 49-57).

Claim 17:   Williams and Fujimoto disclose the method of claim 1.   Williams also

discloses comprising displaying a number of available electronic tokens in the user account on a

computer screen (Col. 18, lines 2-12).

Claim 18:   Williams and Fujimoto disclose the method of claim 1. Williams also

discloses providing products and services that may be purchased through the vendor comprises

providing software to be purchased or rented in exchange for electronic tokens (Col. 18, lines 2-

12 and col. 32, line 57-col. 3, line 4).

Claim 19:   Williams and Fujimoto disclose the method of claim 18. However, the

references does not explicitly disclose providing software to be purchased or rented comprises

providing software that is rented for a limited time. Official notice is taken that the step providing

software to be purchased or rented comprises providing software that is rented for a limited time

is old and well known within the art. One would have been motivated to including this step in

order to increase the number of the user's system.

Claim 20:   Williams and Fujimoto disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented comprises providing software that is rented for a limited number of uses. Official notice is taken that the step providing software to be purchased or rented comprises providing software that is rented for a limited number of uses is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 21:   Williams and Fujimoto disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented comprises providing software that is rented for processing a given task for a specific number of times. Official notice is taken that the step providing software to be purchased or rented comprises providing software that is rented for processing a given task for a specific number of times is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 22:   Williams and Fujimoto disclose the method of claim 18. However, the references does not explicitly disclose providing software to be purchased or rented further comprises permitting the user to extend the software rental in exchange for electronic tokens. Official notice is taken that this step is old and well known within the art. One would have been motivated to including this step in order to increase the number of the user's system.

Claim 23:   Williams and Fujimoto disclose the method of claim 18.   However, the

references does not explicitly disclose providing software to be purchased or rented further

comprises permitting the user to convert rental software to purchased software in exchange for

electronic tokens. Official notice is taken that this step is old and well known within the art. One

would have been motivated to including this step in order to increase the number of the user's

system.

Claim 24:   Williams and Fujimoto disclose the method of claim 18.   Williams also

discloses providing software to be purchased or rented further comprises determining if a selected

software program is already installed on a user's computer, downloading and installing the

selected software program if the selected software program is not already installed on the user's

computer, and sending an authorization code, without downloading the selected software

program, if the selected software program is already installed on the user's computer (Col. 1, lines

55-65 and col. 12, lines 10-40)

Claim 25:   Williams and Fujimoto disclose the method of claim 1.   However, the

references does not explicitly disclose comprising transferring electronic tokens from the user to a

second user. Official notice is taken that this step is old and well known within the art. One

would have been motivated to including this step in order to increase the number of the user's

system.

Claim 26:   Williams and Fujimoto disclose the method of claim 1. Williams also

discloses providing products and services that may be purchased through the vendor comprises

listing products and services for sale by one or more users of a Web site maintained by the vendor

(Col. 1, lines 39-52, col. 12, lines 49-51 and col. 13, lines 19-20).

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

6.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Exr. Pedro R. Kanof whose telephone number is (703) 308-9552. The

examiner can normally be reached on weekdays from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mr. Vincent Millin, can be reached on (703) 308-1065. The fax phone numbers for

this Group is (703) 746-7240 (Non-Official/Draft) and (703) 746-7239 (Official).

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Group receptionist whose telephone number is (703) 305-3900.

FRANTZY POINVIL
PRIMARY EXAMINER

PRK-1/25/2002.

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